

REMARKS

A Request for Continued Examination (RCE) has been filed.

Upon entry of the amendments, claims 1-3, 5-31, 33-45, and 59-60 are now pending. Claims 1, 59 and 60 have been amended. Claim 4 has been canceled without prejudice or disclaimer, the subject matter of which has been added to claims 1, 59 and 60. Claim 32 had previously been canceled without prejudice or disclaimer. Withdrawn claims 46-58 were previously canceled without prejudice or disclaimer. No new matter is entered upon entry of these amendments.

I. Rejections under 35 USC § 112

Claim 1 stands rejected under 35 USC § 112 for allegedly being indefinite because the phrase “at least a portion of” may render the claim unclear. Although Applicants do not necessarily agree, they have removed the offending phrase from claim 1.

II. Rejections under 35 USC § 103

Claims 1-31, 33-45 and 59-60 stand rejected under 35 USC § 103 for allegedly being obvious over U.S. Pat. No. 5,130,342 to McAllister et al., (“McAllister”) in view of U.S. Pat. No. 7,001,556 to Shambaugh (“Shambaugh”) or U.S. Pat. No. 6,764,628 to Lobovsky (“Lobovsky”). Applicants submit that the claims are not obvious in view of these references. Applicants respectfully traverse this rejection because McAllister in view of Shambaugh or Lobovsky, does not teach or suggest to one skilled in the art any method having every element recited in the claims as presently amended. For example, independent claims 1 and 59-60 are directed to processes that include **removing vaporized liquid from a nanotube composite melt**, whereas McAllister is directed to removing liquids, such as by extraction, from **cooled, solidified polymer articles** as described further below.

Applicants also respectfully submit that this rejection is improper because the office action does not set forth the basic requirements of a *prima facie* case of obviousness that is required by MPEP § 2143. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2143, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438. Applicants submit that the Office Action does not properly set forth all three of these requirements and therefore the rejection should be withdrawn. As demonstrated below, Applicants show how one of ordinary skill in the art would not be motivated to modify McAllister to arrive at any claimed invention.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination or modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Independent claims 1 and 59-60 recite processes that include **removing vaporized liquid from a nanotube composite melt**. Applicants submit that McAllister does not so much as suggest the desirability of removing vaporized liquid from a nanotube composite melt. In fact, McAllister teaches **removing liquid from a cooled, solidified polymeric article (Col 5., lines 12-34)**. *Viz.*:

The present invention, in a further aspect, relates to a method for preparing a particulate-filled **microporous** thermoplastic polymeric shaped article which comprises the steps of

- a) dispersing submicron or micron-sized particulate filler in a liquid compatible with the thermoplastic polymer to form a colloidal suspension of the particulate filler in the liquid, the particulate filler being substantially non-agglomerated;
- b) melt-blending the thermoplastic polymer with a solubilizing amount of the compatible liquid containing the dispersed particulate filler at a temperature sufficient to form a homogeneous solution;
- c) forming an article from the solution;
- d) cooling the shaped article at a rate and to a temperature sufficient to initiate thermodynamic, non-equilibrium phase separation;

e) further cooling the article to solidify the thermoplastic polymer; and

f) removing at least a substantial portion of the compatible liquid with the particulate filler remaining substantially entirely within the thermoplastic polymer article.

Accordingly, one of ordinary skill in the art understands McAllister to teach the removal of liquid from a polymer-liquid phase-separated material in which the polymer phase is solidified. One of ordinary skill in the art would readily realize that McAllister's process steps **e) and f) teaches away from removing liquids from polymer melts**. Thus, one of ordinary skill in the art would not be motivated to modify McAllister to arrive at Applicants' claimed invention, as presently amended. For these reasons, Applicants request that this rejection for alleged obviousness be withdrawn. Any claim depending from an independent claim nonobvious under 35 U.S.C. 103 is nonobvious too. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, claims 2-3, 5-31 and 33-45, which depend from independent claim 1 are also nonobvious for these reasons.

Because the combination of references does not disclose, teach or suggest all of the required elements of the claimed invention, Applicants submit that McAllister in view of Shambaugh or Lobovsky does not render obvious the claimed invention and requests withdrawal of the rejection of the claims under 35 U.S.C. § 103(a).

III. Conclusions

Applicants request the Examiner to:

- (1) reconsider and withdraw the standing rejections of the claims in view of the amendments and remarks provided herein; and
- (2) pass claims 1-3, 5-31, 33-45, and 59-60 to allowance.

If the Examiner is of a contrary view, the Examiner is urgently requested to contact the undersigned attorney at (215) 564-8969.

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Respectfully submitted,

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